

REMARKS

INTRODUCTION:

Claims 1-37 are pending and under consideration. Reconsideration is requested.

ENTRY OF AMENDMENT UNDER 37 C.F.R. §1.116:

Applicant requests entry of this Rule 116 Response because:

(1) the response does not significantly alter the scope of the claims and places the application at least into a better form for purposes of appeal. No new features or new issues are being raised.

The Manual of Patent Examining Procedures sets forth in Section 714.12 that "any amendment that would place the case either in condition for allowance or in better form for appeal may be entered." Moreover, Section 714.13 sets forth that "the Proposed Amendment should be given sufficient consideration to determine whether the claims are in condition for allowance and/or whether the issues on appeal are simplified." The Manual of Patent Examining Procedures further articulates that the reason for any non-entry should be explained expressly in the Advisory Action.

OBJECTION TO CLAIMS:

On page 2 of the Office Action, the Examiner objects to claims 36 and 37 under 37 C.F.R. §1.75 as being duplicative of claims 32 and 34. By way of review, claims 32 and 34 depend from 26. Claim 26 recites, among other features, "a second imaging optical sub-system arranged in an optical path between said first imaging optical sub-system and the substrate, wherein said second imaging optical sub-system forms an image of the intermediate image on the substrate and comprises a dioptric imaging system which extends from the intermediate image to the image of the intermediate image."

In contrast, claim 36 recites "a second imaging optical sub-system arranged in an optical path between said first imaging optical sub-system and the substrate, wherein said second imaging optical sub-system forms an image of the intermediate image on the substrate." Claim 37 recites "a second imaging optical sub-system arranged in an optical path between said first imaging optical sub-system and the substrate, wherein said second imaging optical sub-system forms an image of the intermediate image on the substrate." As such, claims 36 and 37 recite at least a different second imaging optical sub-system from that recited in claims 32 and 34 as well as that recited in claim 26, from which claims 32 and 34 depend.

It is therefore respectfully submitted that claims 36 and 37 do not recite the invention as that recited in claims 32 and 34 and it is requested that the objection be reconsidered.

REJECTION UNDER 35 U.S.C. 251:

On pages 2-3 of the Office Action, the Examiner rejects the claims under 35 U.S.C. §251 and requires a Supplemental Declaration under 37 C.F.R. §1.175(b)(1). The rejection is traversed and reconsideration is requested.

Enclosed is a copy of a Supplemental Reissue Declaration compliant with 37 C.F.R. §1.175. As such, it is respectfully requested that the Examiner reconsider and withdraw the rejection.

SUBMISSION OF ORIGINAL PATENT:

On page 4 of the Office Action, the Examiner notes that the original letters patent has not been submitted as is required for the instant application to be allowed. Please find enclosed the original patent in compliance with 37 C.F.R. §1.178. As such, it is respectfully submitted that the applicant has complied with the requirements of 37 CFR §1.178.

STATUS OF CLAIMS NOT REJECTED IN OFFICE ACTION

On page 4 of the Office Action, the Examiner states that claims 1-37 are not rejected in view of prior art.

CONCLUSION:

In accordance with the foregoing, it is respectfully submitted that all outstanding objections and rejections have been overcome and/or rendered moot. And further, that all pending claims patentably distinguish over the prior art. Thus, there being no further outstanding objections or rejections, the application is submitted as being in condition for allowance which action is earnestly solicited. At a minimum, this Amendment should be entered at least for purposes of Appeal as it either clarifies and/or narrows the issues for consideration by the Board.

If the Examiner has any remaining issues to be addressed, it is believed that prosecution can be expedited and possibly concluded by the Examiner contacting the undersigned attorney for a telephone interview to discuss any such remaining issues.

If there are any additional fees associated with the filing of this Response, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

STAAS & HALSEY LLP

By: 
James G. McEwen
Registration No. 41,983

1201 New York Avenue, NW, Suite 700
Washington, D.C. 20005
Telephone: (202) 434-1500
Facsimile: (202) 434-1501

Date: March 29, 2004